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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,810	11/13/2001	Mark Troll	10004082-1	3073

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AGILENT TECHNOLOGIES, INC.
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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,810

Applicant(s)

TROLL, MARK

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 7-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/13/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-6 in the response filed 11/21/03 is acknowledged. The traversal is on the ground(s) that "According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, the Examiner is acknowledging at least implicitly that inventions of the various groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper." This is not found persuasive because the inventions have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for each group of claims requires a different field of search, therefore causing a serious burden on the Examiner.

Claims 7-74 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the response filed 11/21/03.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill

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in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (6,072,924) in view of Miyazawa et al. (5,534,187).

Regarding **claim 1**, Sato et al. discloses a device comprising a solid component and a liquid composition interfaced therewith, the liquid composition having a refractive-index that is substantially equal to that of the solid component (see col. 4, lines 44-51). However, Sato et al. fails to disclose the liquid composition being selected from the group consisting of: a) saturated cyclic compounds consisting essentially of carbon and hydrogen and optionally oxygen, b) benzene substituted with one or more electron-donating groups attached directly to the ring and one or more fluoro groups attached to the ring or to the electron-donating groups, and c) a combination comprising one or more of benzene or substituted benzene and optionally at least one of an alkane or substituted alkane having a boiling point less than about 130°C. Miyazawa et al. teaches that it is old and well-known in the art to have a liquid composition consisting of saturated cyclic compounds, consisting essentially of carbon and hydrogen and optionally oxygen (see column 3, lines 30-67 and col. 4, lines 1-47), or consisting of benzene substituted with one or more electron-donating groups attached directly to the ring and one or more fluoro groups attached to the ring or to the electron-donating groups (see columns 5 and 6), or consisting of a combination comprising one or more of benzene or substituted benzene and optionally at least one of an alkane or substituted alkane having a boiling point less than about 130°C (see column 4, lines 30-47 and columns 5 and 6) for the purpose of producing a liquid composition having the ability to carry a charge in order to complete a desired function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the liquid composition in Sato et al. consist of a) saturated cyclic compounds consisting essentially of carbon and hydrogen and optionally oxygen, or consist of

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b) benzene substituted with one or more electron-donating groups attached directly to the ring and one or more fluoro groups attached to the ring or to the electron-donating groups, or consist of c) a combination comprising one or more of benzene or substituted benzene and optionally at least one of an alkane or substituted alkane having a boiling point less than about 130°C as suggested by Miyazawa et al. in order to have a liquid composition that has an ability to carry a charge in order to complete a desired function.

Regarding **claim 2**, Sato et al. discloses the claimed invention except for the liquid composition consisting of saturated cyclic compounds consisting essentially of carbon, hydrogen and optionally oxygen and further the saturated cyclic compounds comprising one or two rings, each having at least four atoms in the ring. Miyazawa et al. teaches that it is old and well-known in the art to have a liquid composition consisting of saturated cyclic compounds, consisting essentially of carbon and hydrogen and optionally oxygen and further the saturated cyclic compounds comprising one or two rings, each having at least four atoms in the ring (see column 3, lines 30-67 and col. 4, lines 1-47) for the purpose of producing a liquid composition having the ability to carry a charge in order to complete a desired function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the liquid composition in Sato et al. consist of saturated cyclic compounds, consisting essentially of carbon and hydrogen and optionally oxygen and further comprising one or two rings, each having at least four atoms in the ring as suggested by Miyazawa et al. in order to have a liquid composition that has an ability to carry a charge in order to complete a desired function.

Regarding **claim 3**, Sato et al. discloses the claimed invention except for the liquid composition consisting of a benzene substituted with one or more electron-donating groups attached directly to the ring and one or more fluoro groups attached to the ring or to the electron-donating

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groups wherein the electron donating groups are selected from the group consisting of alkyl, alkoxy, hydroxy, and amino (with the proviso that the compound be liquid). Miyazawa et al. teaches that it is old and well-known in the art to have a liquid composition consisting of a benzene substituted with one or more electron-donating groups attached directly to the ring and one or more fluoro groups attached to the ring or to the electron-donating groups wherein the electron donating groups are alkyl groups (see col. 4, lines 5-47) for the purpose of producing a liquid composition having the ability to carry a charge in order to complete a desired function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the liquid composition in Sato et al. consist of a benzene substituted with one or more electron-donating groups attached directly to the ring and one or more fluoro groups attached to the ring or to the electron-donating groups wherein the electron donating groups are alkyl groups as suggested by Miyazawa et al. in order to have a liquid composition that has an ability to carry a charge in order to complete a desired function.

Regarding **claim 4**, Sato et al. discloses the claimed invention except for the liquid composition consisting of a combination comprising one or more of benzene or substituted benzene wherein the weight percent of benzene or substituted benzene in the combination is about 30% to about 90%. Miyazawa et al. teaches that it is old and well-known in the art to have a liquid composition consisting of a combination comprising of or more of benzene or substituted benzene wherein the weight percent of benzene or substituted benzene in the combination is about 30% to about 90% (see columns 85 and 86, examples 11 and 12) for the purpose of producing a liquid composition having the ability to carry a charge in order to complete a desired function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the liquid composition in Sato et al. consist of a combination comprising of or more of

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benzene or substituted benzene wherein the weight percent of benzene or substituted benzene in the combination is about 30% to about 90% as suggested by Miyazawa et al. in order to have a liquid composition that has an ability to carry a charge in order to complete a desired function.

Regarding **claim 5**, Sato et al. discloses the claimed invention except for the liquid composition consisting of a combination comprising one or more of benzene or substituted benzene and optionally at least one of an alkane or an alkane substituted with an hydroxy group, an oxo group, a keto group, or an alkoxy group having a boiling point less than about 130°C. Miyazawa et al. teaches that it is old and well-known in the art to have a liquid composition consisting of a combination comprising one or more of benzene or substituted benzene and optionally at least one of an alkane or an alkane substituted with an hydroxy group, an oxo group, a keto group, or an alkoxy group having a boiling point less than about 130°C (see col. 4, lines 15-47) for the purpose of producing a liquid composition having the ability to carry a charge in order to complete a desired function. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the liquid composition in Sato et al. consist of a combination comprising one or more of benzene or substituted benzene and optionally at least one of an alkane or an alkane substituted with an hydroxy group, an oxo group, a keto group, or an alkoxy group having a boiling point less than about 130°C as suggested by Miyazawa et al. in order to have a liquid composition that has an ability to carry a charge in order to complete a desired function.

Regarding **claim 6**, note in Sato et al. the device comprises a groove in a substrate (see col. 5, lines 35-43).

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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CAS

Catherine Simone
Examiner
Art Unit 1772
February 19, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER

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2/20/04